REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1, 2 and 5-22 are pending in this application, of which claims 1, 10 and 16-19 are independent. All of the pending claims stand rejected. By this amendment, independent claims 1, 10 and 16-19 are amended. No new matter has been added by this amendment.

Rejections under 35 U.S.C. §103

In paragraph two (2) of the Office Action, claims 1, 2, 7, 8, 10, 13 and 16-19 have been finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Pat. No.: 6,157,706 to Rachelson ("Rachelson") in view of U.S. Patent No. 6,097,779 to Oseto ("Oseto"), further in view of US 2002/0075524 to Blair et al. ("Blair") further in view of U.S. Patent No. 6,633,399 to Fukazawa ("Fukazawa"). In paragraph three (3) of the Office Action, claims 5, 12, 14 and 15 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Rachelson, in view of Oseto further in view of Blair further in view of Fukuzawa further in view of U.S. Pat. No.: 6,658,456 to Shimoosawa ("Shimoosawa"). In paragraph four (4) of the Office Action, claim 6 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Rachelson in view of Oseto further in view of Blair further in view of Fukazawa further in view of U.S. Patent No. 6,721,783 to Blossman et al. ("Blossman"). In paragraph five (5) of the Office Action, claims 9 and 11 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Rachelson in view of Oseto further in view of Blair further in view of Fukazawa further in view of U.S. Patent No. 6,883,016 to Fuji et al. ("Fuji"). In paragraph six

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(6) of the Office Action, claims 20-22 have been rejected under 35 U.S.C. §103(a) as allegedly

being unpatentable over Rachelson in view of Oseto further in view of Blair further in view of

Fukazawa further in view of U.S. Patent No. 6,356,356 to Miller, Jr et al. ("Miller").

Independent claims 1, 10 and 16-19 have been amended for further clarification.

Amended claim 1 is directed to a communication apparatus and recites, *inter alia*, that:

> wherein the customized format includes information regarding whether to divide the received
> facsimile data into several pages to create one file from each page or to group all pages of the
> received facsimile data into a single file, for attaching to <u>a single electronic mail</u> for at least one of
> the clients. [Emphasis added]

Other independent claims 10 and 16-19 are amended in a similar manner to claim 1

described above. Support for the amendment may be found throughout the specification as

originally filed including, e.g., paragraphs [0050]-[0057] along with Figs. 6-8 of the

corresponding published application (i.e., U.S. Pub. No. 2002/0080415 A1).

One of the aspects of the present invention as recited in amended claim 1 is to selectively

attach the received facsimile data to each email either by "dividing" the received facsimile data

to create one file, or "grouping" all pages of the received facsimile data into a single file thereby

attaching the created file to each of the emails, i.e., attaching the created file to a **single** email.

In rejecting claim 1, the Examiner correctly admits that the principal reference (i.e.,

Rachelson) does not teach the above aspect of invention, and cites Fukazawa as disclosing this

aspect of invention.[1] The Examiner asserts that:

> Fukazawa '399 discloses wherein the customized format includes information regarding whether
> to divide the image into several pages to create one file from each page or to group all pages of the

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[1] Pages 5-6 of the Office Action.

image into a single file, for attaching to the electronic mail (column 2, lines 63-67; column 3, lines 13-27, 31-44; data file can be divided by the PC4; column 3, lines 60-67; Data file can be divided into page units. Column 5, lines 6-34; received mail can be divided or undivided format; In step s7 the single file is printed.).

Fukazawa discloses an image data processing apparatus in which a data file can be divided into multiple data files so that each of the divided data files can be sent with separate emails. At the recipient side, the divided data files received by the separate emails are stored and subsequently combined together for a printing. See, e.g., col. 3, line 31 - col. 5, line 61. Fukazawa divides the bulky image data into multiple parts so that the transmission time of the separate emails each carrying a piece of divided data file can be reduced. See col. 3, lines 31-39.

Fukazawa, however, fails to teach that the customized format includes information regarding whether to divide the received facsimile data into several pages to create one file from each page or to group all pages of the received facsimile data into a single file, for attaching to a single electronic mail for at least one of the clients, as specifically recited in amended claim 1. For example, while the divided data files are attached to multiple separate emails in Fukazawa, amended claim 1 requires that the file created by dividing the received facsimile data into several pages is attached to a single electronic mail. Moreover, there is simply nothing in Fukazawa that teaches creating a file by "grouping" all pages of the received facsimile data to attach a single electronic mail as also required by amended claim 1.

It appears that the Examiner equates the "step S7" of Fukazawa to the "grouping" aspect of claim 1. However, the relevant section of Fukazawa reveals that the printing step (i.e., S7) simply prints a combined data file after the divided mail data are accumulated thereby restoring an original image. See, e.g., col. 5, lines 49-61.

Applicants believe that none of the other references cited by the Examiner (i.e., Oseto,

Blair, Shimoosawa, Blossman, Fuji and Miller) teaches the inventive aspect of amended claim 1

as discussed above.

Accordingly, each of claims 1, 10 and 16-19 as amended is believed neither anticipated

by nor rendered obvious in view of the references cited by the Examiner (i.e., Rachelson, Oseto,

Blair, Fukazawa, Shimoosawa, Blossman, Fujii and Miller), either taken alone or in combination,

for at least the reasons discussed above. Reconsideration and withdrawal of the rejections of

clams 1, 10 and 16-19 under 35 U.S.C. §103(a) is respectfully requested.

Applicants have chosen in the interest of expediting prosecution of this patent application

to distinguish the cited documents from the pending claims as set forth above. However, these

statements should not be regarded in any way as admissions that the cited documents are, in fact,

prior art. Also, Applicants have not individually addressed the rejections of the dependent

claims because Applicants submit that the independent claims from which they respectively

depend are in condition for allowance as set forth above. Applicants however reserves the right

to address such rejections of the dependent claims should such be necessary.

Applicants believe that the application as amended is in condition for allowance and such

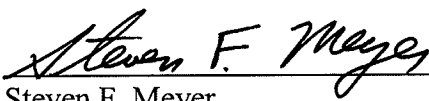action is respectfully requested.

AUTHORIZATION

No petitions or additional fees are believed due for this amendment and/or any accompanying submissions. However, to the extent that any additional fees and/or petition is required, including a petition for extension of time, Applicants hereby petition the Commissioner to grant such petition, and hereby authorizes the Commissioner to charge any additional fees, including any fees which may be required for such petition, or credit any overpayment to Deposit Account No. 50-4827 (Order No. 1232-4792). A DUPLICATE COPY OF THIS SHEET IS ENCLOSED.

An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,
Locke Lord Bissell & Liddell, L.L.P.

Dated: <u>April 10, 2009</u>   By: ___Steven F. Meyer___

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